

REMARKS

Claims 36-41, 49-58, 62-65 are allowed.

New claims 66-68 are added. Support for the new claims is provided by the originally-filed application at, for example, page 12.

Claim 61 is amended as suggested by the Examiner, and therefore, the objection is rendered moot.

Claims 43-45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Holloway (U.S. Patent No. 6,040,249) in view of Kachelmeier (U.S. Patent No. 5,897,354).

Claims 59-60 are rejected under 35 U.S.C. §103(a) as being unpatentable over Holloway and Kachelmeier as applied to claim 43 above, and further in view of Noble, et al. (U.S. Patent No. 6,450,116 B1). Claim 61 is rejected under 35 U.S.C. §103(a) as being unpatentable over Holloway and Kachelmeier as applied to claim 43 above, and further in view of Koyama, et al. (U.S. Patent No. 5,981,366).

Regarding the rejection against claim 43 based on the combination of Holloway and Kachelmeier, claim 43 recites forming conductively doped amorphous silicon physically against the upper portion of the silicon-dioxide-containing layer. The Examiner correctly states Holloway fails to teach this limitation and relies on Kachelmeier to provide the teachings. However, the Examiner states one would be motivated to modify the Holloway device to have the limitations recited by claim 43 by teachings of Kachelmeier because Kachelmeier allegedly teaches: "that amorphous silicon is a suitable alternative gate electrode material to polysilicon" (pg. 5 of paper no. 20060722). However, the MPEP and Federal Circuit Court clearly state that an "alternative material" is not sufficient for establishing the required motivational rationale for modifying the device of a primary reference.

“The initial burden is on the examiner to provide some suggestion of **the desirability** of doing what the inventor has done.” MPEP §2142 (8th ed., rev. 5, vol. 2) (emphasis added). “[T]here must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) cited by MPEP §2143.01 III. (8th ed., rev. 5, vol. 2). An alternative material is just that, an alternative. Without additional teachings that the alternative material provides any benefit or advantage over the material to be replaced, there is simply no motivation, no desirability, to provide the alternative material. That is, without any benefit or advantage for modifying the Holloway device, it is inconceivable that any **desirability** (the motivational rationale) for modifying the Holloway device exists to have an alternative material (such as conductively doped amorphous silicon as recited by claim 43). Since the Examiner has failed to provide the desirability for modifying the Holloway device as the Federal Circuit Court and MPEP state are necessary for a proper obviousness rejection, the obviousness rejection is improper and must be withdrawn.

Stated another way, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in the quote) MPEP §2143.01 III. (8th ed., rev. 5, vol. 2) *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). By presenting a teaching to an alternative material for modifying the primary reference without an advantage or motivation for doing so, the Examiner has simply stated that the references can be modified contrary to Federal Circuit Court authority (and MPEP). The obviousness rejection is improper and must be withdrawn.

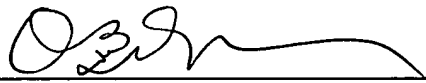
Accordingly, independent claim 43 is allowable.

Claims 44-45, 59-61 and 66-68 depend from claim 43, and therefore, are allowable for depending from allowable independent claim 43.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

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